

### **REMARKS/ARGUMENTS**

Prior to entry of this Amendment, claims 1, 2, 4, 5, 7, 8, 10-15, 17, 18, and 20-24 were pending in this application. No claims have been amended, no claims have been added, and no claims have been canceled herein. Therefore, claims 1, 2, 4, 5, 7, 8, 10-15, 17, 18, and 20-24 remain pending in this application. The Applicants respectfully request reconsideration of this application for at least the reasons presented below.

#### **35 U.S.C. §102 Rejection, Youden**

The Office Action has rejected claims 1-2, 4-5, 7-8, 10-15, 17-18, and 20-24 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,606,359 to Youden et al. (hereinafter "Youden"). The Applicant respectfully submits the following arguments pointing out significant differences between claims 1-2, 4-5, 7-8, 10-15, 17-18, and 20-24 submitted by the Applicants and Youden.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully argue that Youden fails to disclose each and every claimed element. For example, Youden fails to disclose, either expressly or inherently, storing content at a user location before the user specifically requests the content.

Youden is directed to "a video server for providing Video-On-Demand." Under Youden a "data storage system comprises a large capacity archival storage element with a relatively slow data access and transmission rate and a plurality of smaller capacity disk drive arrays with higher data access and transmission rates than the archival storage element." (Col. 2, lines 47-51) "In typical use, video data in the archival storage element must be transcribed to the

disk drive arrays before the video data is accessible to users.” (Col. 2, lines 54-56) That is, Youden describes pre-stripping or caching content from an archive on a disk array.

However, Youden does not disclose, expressly or inherently, storing content at a user location before the user specifically requests the content. Rather, Youden describes providing content to a user’s location, i.e., a user’s STB, from the disk array only after the content has been selected or requested. See for example, col. 3, lines 10-16 and 42-51. As noted in the Office Action (page 3) “a subset of video from the distributor has been pre-stripped (pre-stored) at the disk array.” However, the Applicants contend that Youden does not disclose the disk array being located at a user location and such a reading of Youden would not be reasonable. Rather, such a disk array would be part of the content distributor’s system(s) and would not be at a user location, e.g., a user’s residence (see claims 23 and 24) The Office Action also notes that “a user, through his or her STB makes a request which is transmitted over one of the communication channels in distribution network 20.” The Applicants note that such a transmission, i.e., of the distribution network, would not be required if the content (i.e., the disk array) was at the user’s location. Furthermore, the Applicants respectfully point out that such a transmission does not occur until after the user specifically requests the content. Thus, Youden does not disclose, expressly or inherently, storing content at a user location before the user specifically requests the content. Rather, Youden describes pre-stripping or caching content on a disk array and then providing the content from the disk array to a user location, i.e., the users STB, only after it has been requested by the user.

Claim 1, upon which claims 2, 4-7, and 21-23 depend, is directed to a method for distributing content sent by a content distributor to a user location. Claim 14, upon which claims 15, and 17-20 depend, is directed to a distribution program product having code for distributing content sent by a content distributor to a user location. Both claim 1 and claim 14 recite in part “receiving a command from the content distributor to store the content at the user location before a user specifically requests the content, wherein the content comprises a subset of content available from the content distributor, the subset associated with a premium subscription service,

and wherein the content comprises at least one of a video program or an audio program.” Youden does not disclose, expressly or inherently, storing content at a user location before the user specifically requests the content. Rather, Youden describes pre-stripping or caching content on a disk array and then providing the content from the disk array to a user location, i.e., the users STB, only after it has been requested by the user. For at least these reasons, the rejection is improper and claims 1-2, 4-7, 14-15, and 17-22 should be allowed.

Claim 8, upon which claims 9-13 and 24 depend, is directed to a method for distributing content sent by a content distributor to a user location and recites in part “determining a subset of content from a larger set of content available from the content distributor, wherein the subset of content is associated with a premium subscription service”, “commanding the user location to store the content from the content distributor without a user associated with the user location specifically requesting the content”, and “sending the content to the user location for storage before a user specifically requests the, wherein the content comprises at least one of a video program or an audio program.” Youden does not describe, expressly or inherently, storing content at a user location before the user specifically requests the content. Rather, Youden describes pre-stripping or caching content on a disk array and then providing the content from the disk array to a user location, i.e., the users STB, only after it has been requested by the user. For at least these reasons, the rejection is improper and claims 8-13 and 24 should be allowed.

### **CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Appl. No. 09/687,157  
Amdt. dated November 12, 2008  
Reply to Office Action of August 14, 2008

---

PATENT

Dated: November 12, 2008

Respectfully submitted,

/William J. Daley/  
William J. Daley  
Reg. No. 52,471

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 303-571-4000 (Denver)  
Fax: 303-571-4321 (Denver)  
WJD:jcp  
61544113 v1